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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,600	11/15/2000	Harold Kraft	61000/101	9771

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EXAMINER	
LE, MIRANDA	
ART UNIT	**PAPER NUMBER**
2167	

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/713,600	KRAFT ET AL.	
	Examiner	Art Unit	
	Miranda Le	2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 October 2005*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-54* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-37,39,41 and 43-54* is/are rejected.

7)☒ Claim(s) *38, 40, 42* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/13/2005 has been entered.

This communication is responsive to Amendment filed 10/13/2005.

2. Claims 1-54 are pending in this application. Claims 1, 13, 25, 49, 51, 53 are independent claims. This action is made non-Final.

Response to Arguments

3. The declaration under 37 CFR 1 .131 filed on October 13, 2005 has been considered, but is insufficient to overcome the rejection of claims 1-54 over Gao under 35 USC § 102 (e) as set forth in the last Office action filed 04/08/05, because it is not properly executed and fails to establish reduction to practice prior to the date of the reference.

I. Formalities: The affidavit is ineffective because it was not properly executed. It was not signed by all inventors. See MPEP 715.04. Applicant has not met any of the criteria. Therefore, the affidavit is ineffective on its face.

II. Reduction to practice: Applicant attempts to establish prior invention by showing RTP of the invention prior to the July 16, 1998, the effective filing date of Gao.

a. The evidence submitted is insufficient to establish a reduction to practice of the

invention in this country or a NAFTA or WTO member country prior to the effective date of the Gao reference.

The affidavit does not establish where the reduction to practice took place. The reduction to practice of the invention must have taken place in this country or a NAFTA or WTO member country.

b. Insofar as applicant is relying on the invention disclosure to establish reduction to practice, a written description does not constitute an actual reduction to practice. Furthermore, only the filing of a US patent application, which complies with the disclosure requirement of 35 USC 112 constitutes a constructive reduction to practice. A written description, no matter how complete, does not qualify as an actual reduction to practice.

Establishment of actual reduction to practice requires applicant to show that applicant constructed an embodiment or performed a process that met every claimed element and the embodiment or process operated for its intended purpose. Testing is required to establish an actual reduction to practice. See MPEP 715.07 and 2138.05. Therefore, the evidence submitted is insufficient to establish an actual reduction to practice of the invention.

4. Applicant's arguments filed on 10/13/2005 have been fully considered but they are not persuasive.

Applicant argues that Gao is not available as a prior art reference because applicant's 131 affidavit establishes a reduction to practice prior to Gao's filing date. However, the evidence submitted is insufficient to establish a reduction to practice as described above in paragraph 3. Therefore, the rejection is maintain, Gao is available as a prior art.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless:
>
> (e) the invention was described in
>
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
>
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, 5-9, 13-14, 17-21, 25-26, 29-33, 37, 39, 41, 43-45, 49-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Gao et al. (US Patent No. 6,490,579 B1).

Gao anticipated independent claims 1, 13, 25, 49, 51, 53, by the following:

As to claims 1, 13, 25, Gao teaches a method for retrieving data, comprising: selecting one of a plurality of user input (i.e. Context field 366, Query field 364), stored electronic records search requests from a queued search database to execute next based upon one or more selection criteria (i.e. Subject Areas, col. 7, lines 17-30, col. 8, line 58 to col. 9, line 18, col. 8, lines 47-57, col. 9, lines 31-59, Figs. 1, 3);

executing the selected electronic records search request and retrieving at least one electronic record from at least one storage location during the executing (col. 8, lines 6-27);

parsing the electronic records to convert one or more raw data sets into user selectable objects (col. 3, lines 20-35, col. 8, lines 6-27, col. 9, line 60 to col. 10, line 7, Fig. 5-step 518);

causing the user-selectable objects to be displayed (col. 9, line 60 to col. 10, line 7, Fig. 5-step 526).

As to claims 49, 51, 53, Gao teaches a method for determining which of a plurality of queued search request to implement, the method comprising: evaluating one or more user input, electronic records search requests using one or more search selection criteria (col. 8, line 46 to col. 9, line 18);

selecting one of the user input, electronic records search requests to execute next based upon the evaluation (col. 8, line 46 to col. 9, line 18);

executing the selected search (col. 8, line 46 to col. 9, line 18, col. 9, line 60 to col. 10, line 7).

As to claims 2, 14, 26, Gao teaches selecting at least one of the user-selectable objects to retrieve the raw data set associated with the selected object (Fig. 5-step 526).

As to claims 5, 17, 29, Gao teaches the parsing further comprises extracting the at least one raw data set (i.e. Data extraction pattern) from the retrieved electronic records (col. 9, line 60 to col. 10, line 7, Fig. 5-step 524).

As to claims 6, 18, 30, Gao teaches the parsing is implemented by at least one data processing algorithm based substantially on an artificial intelligence (i.e. where, what and how the information is gathered, col. 7, lines 1-30, col. 5, lines 55-67).

As to claims 7, 19, 31, Gao teaches determining at least one data parsing algorithm that should be used for parsing the retrieved records based upon a content of the retrieved electronic records (i.e. Pattern to extract information, col. 3, lines 20-35, col. 7, lines 1-30);

executing the parsing using the at least one determined data parsing algorithm (col. 7, lines 1-30).

As to claims 8, 20, 32, Gao teaches the parsing further comprises filtering (i.e. Subject Areas, Information Type, Problem Type, col. 7, lines 1-30, Fig. 1), sorting (Ranking 170, Fig. 1) or analyzing the retrieved electronic records for data consistency (col. 3, lines 20-35, col. 7, lines 1-30).

As to claims 9, 21, 33, Gao teaches determining if at least one of a plurality of electronic records databases associated with each electronic records search request is accessible through a first or a second communication medium (col. 4, line 66 to col. 5, line 54, Fig. 1);

accessing the at least one electronic records database through the first or the second communication medium based on the determination (i.e. information sources may include various web site and proprietary databases, col. 5, lines 38-39, Fig. 1).

As to claims 37, 39, 41, Gao teaches the selecting one of the plurality of electronic records search requests to execute next based upon the one or more selection criteria further comprises examining search data associated with each of the electronic records search requests and evaluating the search data using the one or more selection criteria (col. 6, lines 32-53, col. 7, lines 19-63, col. 5, lines 29-44, col. 6, lines 11-63).

As to claims 43, 44, 45, Gao teaches one or more of the stored search requests are stored (i.e. batch processing) in a search database when the search request cannot be executed at the time the search request is made (col. 9, lines 31-46).

As to claims 50, 52, 54, Gao teaches one or more search selection criteria comprises an age of the examined electronic records search request (col. 9, lines 31-46).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 3-4, 15-16, 27-28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gao et al. (US Patent No. 6,490,579 B1), in view of Wolfe et al. (US Patent No. 6,263,351 B1).

As to claims 3, 15, 27, Gao does not explicitly teach "the raw data sets comprise court case items or documents associated with a court case docket sheet". However, Wolfe teaches this limitation at col. 2, lines 17-25, col. 5, lines 54-65.

It would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the teachings of Gao with the teachings of Wolfe to include "pairing each said seed element with every other seed element in the input set and creating a first linkage between each pair of elements" because it would provide an efficient procedure for an on-line legal research system which is applicable to research documents that extensively cite or refer to other document.

As to claims 4, 16, 28, Gao does not explicitly teach "the electronic records comprise results of an executed electronic court case records search request, at least one criterion used in formulating the electronic court case records search request and data related to at least one electronic court database associated with the electronic court case records search request". However, Wolfe teaches this limitation at col. 7, line 21 to col. 8, line 38.

It would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the teachings of Gao with the teachings of Wolfe to include "the electronic records comprise results of an executed electronic court case records search request, at least one criterion used in formulating the electronic court case records search request and data related to at least one electronic court database associated with the electronic court case records search request" because it would provide an efficient procedure for an on-line legal research system which is applicable to research documents that extensively cite or refer to other document.

9. Claims 10, 12, 22, 24, 34, 36, 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gao et al. (US Patent No. 6,490,579 B1), in view of Crim et al. (US Patent No. 5,920,866).

As to claims 10, 22, 34, Gao does not explicitly teach "the plurality of electronic record databases comprises at least one first electronic court database accessible through the first communication medium and at least one second electronic court database accessible through the second communication medium". However, Crim teaches this limitation at col. 6, lines 39-54, col. 14, lines 22-47, col. 15, lines 19-24.

It would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the teachings of Gao with the teachings of Crim to include "the plurality of electronic record databases comprises at least one first electronic court database accessible through the first communication medium and at least one second electronic court database accessible through the second communication medium" because it would allow users to organize, maintain and store vast amounts of data in a form which could be easily recalled and updated.

As to claims 12, 24, 36, Gao does not explicitly teach "the electronic records search requests comprise court case docket sheet search requests". However, Crim teaches this limitation at col. 5, line 52 to col. 6, line 26, Fig. 3.

It would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the teachings of Gao with the teachings of Crim to include "the electronic records search requests comprise court case docket sheet search requests" because it would allow users

to organize, maintain and store vast amounts of data in a form which could be easily recalled and updated.

As to claims 46, 47, 48, Gao does not explicitly teach "retrieving one or more hard-copy documents associated with a selected user-selectable object". However, Crim teaches this limitation at col. 6, lines 1-26.

It would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the teachings of Gao with the teachings of Crim to include "retrieving one or more hard-copy documents associated with a selected user-selectable object" because it would allow users to organize, maintain and store vast amounts of data in a form which could be easily recalled and updated.

10. Claims 11, 23, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gao et al. (US Patent No. 6,490,579 B1), in view of Subramaniam et al. (US Patent No. 5,859,972).

As to claims 11, 23, 35, Gao teaches "the second communication medium comprises an Internet connection" at col. 4, line 66 to col. 5, line 3, but Gao does not expressly teach "the first communication medium comprises a telephone dial-up modem connection". However, Subramaniam teaches this limitation at col. 5, line 67 to col. 6, line 3.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Gao with the teachings of Subramaniam to include "the first communication medium comprises a telephone dial-up modem connection" in order to allow

databases to be accessed through both the Internet and the telephone line so that the databases can be located remotely.

Allowable Subject Matter

11. Claims 38, 40, 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (571) 272-4112. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jean Homere, Esq., can be reached on (571) 272-3780. The fax number to this Art Unit is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Miranda Le
January 06, 2006